REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 1-21 remain actively pending in the case. No new matter has been added. Reconsideration of the claim is respectfully requested.

In paragraph 4 on page 2 of the Office Action, claims 1-21 were provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 of copending Application No. 10/051,340. The Applicants respectfully traverse this rejection, but in the interest of expediting prosecution have attached hereto a terminal disclaimer to overcome the objection. Therefore, Applicants' respectfully request that the objection be withdrawn.

In paragraph 6 on page 3 of the Office Action, claims 1-7, 9-17 and 19-21 were rejected under 35 USC §102(e) as being anticipated by Smart et al. (2003/0208691). In paragraph 22 on page 7 of the Office Action, claims 8 and 18 were rejected under 35 USC §103(a) as being unpatentable over Smart et al. in view of what was well known in the art. Applicants respectfully traverse the rejections.

Smart fails to teach or suggest at least providing an offering at said order terminal based on said business relationship associated with said digital storage device as required by Applicants' independent claims. Smart discloses that when a new device is connected to a local network 100, a multicast announcement is broadcasted to other users on the network. Accordingly, devices currently on the network learn of the new device, and the new device learns of the devices currently on the network. For example, a new device, such as a camera 102, can identify the population of devices already connected to the network, and is aware of their attributes and capabilities. *See* paragraph [0081]. The new device will then determine if its own attributes (i.e., criterion) are compatible with the equipment currently attached to the network, such as a printer, and if so, will use the currently attached equipment to perform a task, such as printing a document. *See* paragraph [0081], [0082] and [0115]. Further, devices on a large network can use a Service Description Directory that represents devices connected to the large network. *See* paragraphs [0053] and [0054]. Smart may also use other criterion to establish compatibility as disclosed in Table 1 of Smart. *See* page 8.

However, Smart does not disclose a provision for an offering at an order terminal. Also, Smart does not base the offering on a business relationship associated with a digital storage device. At best, Smart uses the profile process to create compatibility matches between devices, such a camera and a printer. *See* [0115]. In sharp contrast, Applicants' invention first requires information, with respect to a business relationship, between photo service providers and a plurality of business entities. Accordingly, the number and order of services offered at an order terminal is based on the business relationships between, for example, a business entity associated with the digital storage device (i.e., the digital storage device includes code which identifies the business entity. *see* claim 3) and the photo service providers. *See* pages 24-27 and Fig. 8 of Applicants' Specification.

> In order to render a claim anticipated by the prior art, each and every element of the claim must be disclosed in a single reference. In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303,1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "'usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term.'" Id. (quoting *Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576*, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317.

With respect to the Office Action taking official notice to claims 8 and 18, Applicants respectfully assert that a business relationship being a hostile relationship do not constitute facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. The references relied on by the Examiner, for example, fail to disclose this purportedly "well known" fact. Applicants contend that reasonable doubt exists regarding the circumstances justifying the Examiner's exercise of official notice, and request that the Examiner provide evidence that demonstrates the appropriateness of the officially noticed facts pursuant to MPEP § 2144.03. Applicants reserve the opportunity to respond to the Examiner's comments concerning any such judicially noticed facts.

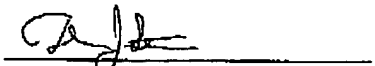
Therefore, in view of the above remarks, Applicants' independent claims are patentable over the cited reference. Because claims 2-9 and 11-20 depend from claims 1 and 10, respectively, and include the features recited in the

independent claim, Applicants respectfully submit that claims 2-9 and 11-20 are also patentably distinct over the cited reference. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Please charge any necessary fees to Eastman Kodak Company Deposit Account No. 05-0225.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.